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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/343,686	11/21/94	KELLER G	287926

18M2/1112

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EXAMINER	
LANKFORD JR,L	

ART UNIT	PAPER NUMBER
1806	16

DATE MAILED: 11/12/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/343,686	Keller et al
Examiner	**Group Art Unit**
L. Blaine Lankford	1808

☒ Responsive to communication(s) filed on *Aug 1, 1997*.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-35, 37-56, and 58-108* is/are pending in the application.

Of the above, claim(s) *1-26 and 60-107* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *27-35, 37-56, 58, 59, and 108* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *14*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claims 27-35, 37-56, 58-59 & 108 (newly submitted claim 107 was renumbered 108 by rule 126) are considered on the merits.

Applicant's arguments filed 8-1-97 are persuasive to overcomethe rejection under 35 USC 112, however the arguments regarding the prior art rejection have been fully considered but they are not persuasive. The rejection is therefore maintained and repeated below. Applicant's arguments have been considered however a showing to overcome a prima facie case of obviousness must be clear and convincing (In re Lohr et al. 137 USPQ 548) as well as commensurate in scope with the claimed subject matter (In re Lindner 173 USPQ 356; In re Hyson, 172 USPQ 399 and In re Boesch et al., 205 USPQ 215 (CCPA 1980). Applicants arguments do not appear to distinguish the cells disclosed by Wiles et al are different from those applicant claims even if the methods for producing them are different. As the references clearly indicate that the various proportions and amounts of the ingredients used in the claimed method are result effective variables, they would be routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by that reference.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 27-35, 37-56, 58-59 & 108 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wiles et al(R).

Applicant claims an embryonic blast cell population.

Wiles et al disclose an embryonic blast cell population which appear to be identical to applicant's claimed invention. The reference anticipates the claim subject matter.

However, even if the reference's populations and the claimed populations are not one and the same and there is, in fact, no anticipation, the reference preparations would, nevertheless, have rendered the claimed population obvious to one of ordinary skill in the art at the time the claimed invention was made in view of the clear close relationship between the cells.

Thus, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the references, especially in the absence of evidence to the contrary.

The Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not Applicants' populations differ and, if so, to what extent, from that discussed in the references. Therefore, with the showing of the references, the burden of establishing non-obviousness by objective evidence is shifted to Applicants.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

5. Accordingly, the claimed invention was prima facie obvious to one of ordinary skill in the art at the time the invention was made especially in the absence of evidence to the contrary.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Blaine Lankford whose telephone number is (703) 308-2455.

LBL

November 10, 1997

LEON B. LANKFORD, JR.
PRIMARY EXAMINER
GROUP 1800